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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,206	02/10/2005	Pascale Lacan	ESSR:091US	9943
32425 7590 08/14/2007 FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701			EXAMINER BASHORE, ALAIN L	
			ART UNIT 1762	PAPER NUMBER
			MAIL DATE 08/14/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/524,206	Applicant(s) LACAN ET AL.	
	Examiner Alain L. Bashore	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 28-71 is/are pending in the application.
- 4a) Of the above claim(s) 62-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. The election with traversal of claims 28-61 is hereby acknowledged. The previous restriction requirement is withdrawn as applicant's arguments are persuasive regarding the argument of: no commonly shared technical feature. A new restriction requirement under 35 USC 121 and 372 is hereby made below with prior art to show no special technical feature present. The special technical feature is described by applicant in the previous response to a restriction requirement dated 6-13-07. The new restriction requirement given below is not made final, but the invention has been constructively elected by original presentation for prosecution on the merits regarding method claims only.

2. Claims 62-71 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6-13-07. A claims set must reflect the withdrawn status of claims 62-71 or the response will be considered non-responsive.

3. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 28-62, drawn to method.

Group II, claim(s) 62-71, drawn to article.

4. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The references to Lacan et al (WO 02/092524) in view of Singh et al disclose: forming a non-fluorinated metallic oxide and/or a hydroxide layer on a MgF<sub>2</sub> temporary protective layer, the temporary layer being coated on an organic or mineral external layer of an ophthalmic lens. The reasons for combining the two references are given in the 35 USC 103 rejection below. The special technical feature is identified by applicant in the previous response to a restriction requirement dated 6-13-07.

5. The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 28-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lacan et al (WO 02/092524) in view of Singh et al.

The reference to Lacan et al has as english equivalent US patent application 2003/0049370 (made of record). While the rejection is regarding the WIPO publication, reference will be made to the english equivalent.

Lacan et al discloses a method for treating an ophthalmic lens comprising two main sides, wherein at least one side comprises an organic or mineral external layer coated with a  $\text{MgF}_2$  temporary protective layer (see para 0049 and 0050 to English equivalent). Also disclosed is hydrophobic and/or oilophobic surface (para 0030), thickness ranges (para 0056, 0098), vacuum evaporation coating (0055).

Lacan et al does not disclose:

a liquid phase chemical treatment of the temporary protective layer,  
leading to the formation of  $\text{MgO}$  and/or  $\text{Mg}(\text{OH})_2$  in and/or on the  
temporary protective layer;

or

a deposit of at least one non-fluorinated metallic oxide and/or of at least  
one non fluorinated metallic hydroxide on the temporary protective layer;

Singh et al discloses a deposit of at least one non-fluorinated metallic oxide  
and/or of at least one non fluorinated metallic hydroxide on a magnesium fluoride  
protective layer (col 3, lines 3-29).

It would have been obvious to one with ordinary skill in the art to include a  
deposit of at least one non-fluorinated metallic oxide and/or of at least one non  
fluorinated metallic hydroxide on the temporary protective layer because Singh teaches

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magnesium fluoride coatings to have undesirable characteristics that require modification (col 1, lines 30-60).

Regarding a specific claimed parameter not explicitly disclosed, it would have been obvious to one with ordinary skill in art to combine for the purposes of routine experimentation, in absence of criticality of result.

8. Claims 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lacan et al (WO 02/092524) in view of Singh et al as applied to claims above, and further in view of Medwick et al.

Lacan et al and Singh et al do not disclose the metal oxide as of magnesium.

Medwick discloses different metal oxides (col 6, lines 42-43).

It would have been obvious to one with ordinary skill in the art to magnesium as the metal for the oxide thereof because Medwick teaches as desirable the metallic oxide has transparent or substantially transparent to visible light as a property (col 6, lines 46).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 571-272-6739. The examiner can normally be reached on about 7:30 am to 5:00 pm (Mon. thru Thurs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alain L. Bashore/  
Primary Examiner  
Art Unit 1762